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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,666	02/20/2004	Jan Kall	59643.00379	5521

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EXAMINER

IWUCHUKWU, EMEKA DERRICK

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 06/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/781,666	KALL ET AL.	
	Examiner	Art Unit	
	Emeka D. Iwuchukwu	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-15 and 17-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-15 and 17-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Art Unit Notice

1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

Response to Amendment

2. This Office Action is in response to the amendment filed on 05/11/2006.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claim 9** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation "The method according to claim 4" in Line 1. There is insufficient antecedent basis for this limitation in the claim as claim 4 has been cancelled. The Office shall interpret the claim to read "The method according to claim 1".

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for

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patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1,2,7,8,13,14,19,20 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Publication 2002/0168978 A1 to Molnar et al. (*hereinafter Molnar*).

With respect to claims 1&13, Molnar teaches a method for controlling sending of messages in a communication system and the communication system, comprising providing a network entity with restriction information associated with terminating parties in the communication system; determining at least one terminating party for a message to be sent; defining restriction information associated with the terminating parties to comprise a restriction level for sending the message to the at least one terminating party; and controlling sending of the message based on the restriction information (paragraphs 12,41).

With respect to claims 2&14, Molnar teaches the method and system of claims 1&13 respectively, wherein the controlling step comprises deciding if the sending of the message is allowed or denied (paragraph 12).

With respect to claims 7&19, Molnar teaches the method and system of claims 1&13 respectively, further comprising defining the restriction level in function of a type of the at least one terminating party (paragraph 41).

With respect to claims 8&20, Molnar teaches the method and system of claims 7&19 respectively, wherein defining the restriction level comprises classifying the terminating party as private, confidential or public (paragraph 41).

7. Claims 1,9,13&21 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Publication 2004/0123097 A1 to Ranjan.

With respect to claims 1&13, Ranjan teaches a method for controlling sending of messages in a communication system and the communication system, comprising providing a network entity with restriction information associated with terminating parties in the communication system; determining at least one terminating party for a message to be sent; defining the restriction information associated with the terminating parties to comprise a restriction level for sending the message to the at least one terminating party; and controlling sending of the message based on the restriction information (paragraphs 42,43).

With respect to claims 9&21, Ranjan teaches the method and system of claims 1&13, further comprising defining the restriction level for a receiver group address in function of an estimated amount of terminating parties (paragraph 43).

8. **Claim 12** is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Publication 2003/0172077 A1 to Moussavian.

Moussavian teaches the computer program, comprising program code means embodies on a computer readable medium (paragraph 123), said computer program controlling a computer to perform the steps of: providing a network entity with restriction information associated with terminating parties in a communication system; determining at least one terminating party for a message to be sent; defining restriction information associated with the terminating parties to comprise a restriction level for sending the message to the at least one terminating party; and controlling sending of the message based on the restriction information (paragraphs 39,45,46).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. **Claims 5,6,17&18** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent Publication 2002/0168978 A1 to Molnar et al. (*hereinafter Molnar*) in view of U.S. Patent No. 5,678179 to Turcotte et al. (*hereinafter Turcotte*).

Molnar teaches the method and system of claims 1&13. Molnar fails to expressly disclose defining the restriction level in function of a type of the message.

In the same field of endeavor, Turcotte teaches a similar method and system, further comprising defining the restriction level in function of a type of the message and classifying the message as private, confidential or public (Table 2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to define the restriction level of the message as private, confidential or public for enhanced security.

12. **Claims 10,11,22-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent Publication 2002/0168978 A1 to Molnar et al. (*hereinafter Molnar*) in view of U.S. Patent Publication 2003/0196098 A1 to Dickinson, III et al. (*hereinafter Dickinson*).

With respect to claims 10,11,22-24, Molnar teaches the method and system of claims 2&14. Molnar fails to specifically mention the further steps of determining an action to be taken in relation to a denied message to modify the message into a form in which the sending is allowed.

In the same field of endeavor, Dickinson teaches a similar method and system further comprising, when the sending of the message is denied, modifying the message by removing a selected type of attachment file before allowing the sending of the message (paragraph 25).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify an otherwise denied message by removing a selected type of attachment file into a form in which the sending is allowed so as to prevent virus programs from affecting a recipients computer as taught by Dickinson.

With respect to claims 25&26 Molnar teaches the communication system of claim 13. Molnar fails to specifically mention the network entity is selected from a group comprising at least one of a user equipment, a serving controller, an application server and a subscriber information register (paragraph 34).

In the same field of endeavor Dickinson teaches a similar system, wherein the network entity is selected from group comprising at least one of a user equipment, a serving controller, an application server and a subscriber information register and comprises an email server (paragraph 34), the controlling means comprises a domain checking function block connected or included in the email server (paragraph 9), and the terminating party comprises an email client of a receiver (paragraph 39).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the network entity comprise an email server, the controlling means comprise a domain checking function block connected or included in the email server and the terminating party comprise an email client of the receiver to transfer secure email messages as taught by Dickinson (paragraphs 9,10).

13. **Claim 12** is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication 2002/0168978 A1 to Molnar et al. (*hereinafter Molnar*) in view of U.S. Patent Publication 2003/0172077 A1 to Moussavian.

Molnar teaches the steps of providing a network entity with restriction information associated with terminating parties in the communication system; determining at least one terminating party for a message to be sent; defining restriction information associated with the terminating parties to comprise a restriction level for sending the message to the at least one terminating party and controlling sending of the message based on the restriction information (paragraphs 12,41). Molnar fails to expressly disclose the steps as a program code embodied on a computer readable medium.

In the same field of endeavor, Moussavian teaches a computer program, comprising program code means embodied on a computer readable medium (paragraphs 39,45,46,123), said computer program controlling a computer to perform similar steps.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the steps as program code on a computer readable medium for the advantage of loading executing the steps on a machine, such as a computer, enabling the machine to become an apparatus for practicing the invention as taught by Moussavian (paragraph 123).

14. **Claim 27** is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication 2002/0168978 A1 to Molnar et al. (*hereinafter Molnar*) in view of U.S. Patent Publication 2004/0203947 A1 to Moles.

Molnar teaches the communication system according to claim 13. Molnar fails to specifically mention the network entity comprises a serving controller in an Internet Protocol Multimedia subsystem.

In the same field of endeavor, Moles teaches a similar communication system wherein the network entity comprises a serving controller in an Internet Protocol Multimedia subsystem (paragraph 37), the controlling means is included in an application server communicating with the serving controller (paragraphs 37,51), and the terminating party comprises a user equipment connected to the Internet Protocol Multimedia subsystem (paragraph 48).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a network entity that comprises a serving controller in an Internet Protocol Multimedia subsystem, the controlling means is included in an application server communicating with the serving controller, and the terminating party comprises a user equipment connected to the Internet Protocol Multimedia subsystem to transmit e-mail messages as taught by Moles (paragraphs 37,47-51).

15. **Claim 28** is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication 2002/0168978 A1 to Molnar et al. (*hereinafter Molnar*) in view of U.S. Patent Publication 2001/0053687 to Sivula.

Molnar teaches the communication system according to claim 13. Molnar fails to expressly disclose the network entity comprises a multimedia message service server.

In the same field of endeavor, Sivula teaches a similar communication system, wherein the network entity comprises a multimedia message service server (paragraph 49), the controlling means is included in an application server communicating with the multimedia message service server (paragraph 46) and the terminating party comprises a multimedia message service user agent of a receiver (paragraphs 33,53).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a network entity comprising a multimedia message service server, the controlling means is included in an application server communicating with the multimedia message service server and the terminating party comprises a multimedia message service user agent of a receiver so multimedia messages can be sent to devices that support them as taught by Sivula (paragraphs 33,46,49,53).

16. Claims 1,2,3,13,14&15 are rejected under 35 U.S.C. 103(a) as being anticipated by U.S. Patent Publication 2003/0083078 A1 to Allison et al. (*hereinafter Allison*) in view of U.S. Patent Publication 2002/0168978 A1 to Molnar et al. (*hereinafter Molnar*).

With respect to claims 1&13, Allison teaches a method for controlling sending of messages in a communication system and the communication system, comprising providing a network entity with restriction information associated with terminating parties in the communication system; determining at least one terminating party for a message to be sent; and controlling sending of the message based on the restriction information (paragraph 16). Allison fails to expressly disclose defining the restriction information associated with the terminating parties to comprise a restriction level for sending the message to the at least one terminating party.

In the same field of endeavor, Molnar teaches a similar method and system comprising the step of defining the restriction information associated with the terminating parties to comprise a restriction level for sending the message to the at least one terminating party (paragraph 41).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to define the restriction information associated with the terminating parties to comprise a restriction level for sending the message to the at least one terminating party so that only private subscribers or members of a family receive a message as taught by Molnar (paragraph 41).

With respect to claims 2&14, Allison in view of Molnar teaches the method and system of claims 1&13 wherein the controlling step comprises deciding if the sending of the message is allowed or denied (paragraph 16).

With respect to claims 3&15, Allison in view of Molnar teaches the method and system of claims 2&14 further comprising, when the sending of the message is denied, providing a warning message in response to a sending command (paragraph 16).

Response to Arguments

17. Applicant's arguments filed 05/11/2006 have been fully considered but they are not persuasive.

Applicant argues that Molnar fails to teach or disclose that the restriction information comprises a restriction level for sending the message to at least one terminating party because the sole criterion used is whether the communication with a particular address is allowable (pages

9&10, last paragraph of the response); applicant makes similar allegations throughout the full body of the response all of which are addressed as follows.

The Examiner respectfully disagrees with applicant. Molnar teaches “defining the restriction information associated with the terminating parties to comprise a restriction level for sending the message to the at least one terminating party” by defining certain addresses as allowed and certain addresses as restricted.

The Examiner also points out Line 2 of the first full paragraph on page 10, where the applicant states “*the concept of restriction levels ... includes not just that a message can or cannot be sent ... but that particular recipients are categorized ...*” The applicant therefore admits that whether a message can or cannot be sent reads on the broad definition of a restriction level.

It is noted that the feature upon which applicant relies (i.e., categorizing recipients) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emeka D. Iwuchukwu whose telephone number is (571) 272-5512. The examiner can normally be reached on M-F (9AM - 5.30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duc Nguyen can be reached on (571) 272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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